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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/185,243	11/03/1998	TOM TSANG	15907-0016	5192

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EXAMINER

PRIEBE, SCOTT DAVID

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/185,243	Applicant(s) TSANG ET AL.	
	Examiner Scott D. Priebe	Art Unit 1632	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☒ Newly proposed or amended claim(s) 48-55,68 and 70-75 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 48-75.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Scott D. Priebe

Scott D. Priebe
Primary Examiner
Art Unit: 1632

Continuation of 2. NOTE: Proposed claim 69 depends from cancelled claim 49, resulting in a lack of antecedent basis.

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant refers to MPEP 2164.01 and argues that since the claimed invention is enabled for in vitro uses, claims 56-67 are enabled even if the method is performed in vivo. However, MPEP 2164.01 is directed to enablement for using a claimed product, not enablement for the full scope of a claimed method. The cells upon which the method is practiced in vitro, e.g. cultured cells, are not the same as cells in vivo, i.e. in an organism such as a mammal, and the goal of such methods are also different.

Applicant further argues the specification discloses uses for the method when practiced on cells in vivo that are non-therapeutic, Example 4 is referred to and characterized as a research tool for testing the ability of a selected polynucleotide to affect tumor growth. However, the example states "[M]ouse models of human cancer ... can be treated with the therapeutic compositions of the present invention," and "[T]he efficacy of these treatments is indicated by ... as a result of the administration of the therapeutic compositions of the present invention". This is an indication that the therapeutic capability of the claimed invention itself is being tested, not that the method is a general research tool as asserted by Applicant.

Applicant also refers to MPEP 2164.01(a) regarding the preference that a patent omit what is well known in the art, citing 16 references in support that uses for expression constructs to express polynucleotides in vivo were well known in the art. However, as indicated in item 6, the references have not been considered. Consequently, this argument is moot.